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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/019,161 | 03/01/2002 | Isabelle Betremieux | 119464 | 1665 |
| 26316 | 7590 | 01/07/2004 | EXAMINER | |
| COZEN AND O'CONNOR 1900 MARKET STREET PHILADELPHIA, PA 19103 | | | FORTUNA, JOSE A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1731 | |

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,161

Applicant(s)

BETREMIEUX ET AL.

Examiner

José A Fortuna

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed on October 27, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: the absence of conventional accessory surfactants has not support in the specification. The specification does not define what is to be considered conventional or the meaning of accessory surfactants. The support needs to be, directly or indirectly, in the specification not in the words of the prior art.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-15 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase “in the absence of conventional accessory surfactant,” is not supported by the original specification, see above.

Art Unit: 1731

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite as to what is to be considered "conventional."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-15 and 20 are rejected under 35 USC §102(b). This rejection is set forth in the prior Office action mailed on July 25, 2003.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19 are rejected under 35 USC §103(a). This rejection is set forth in the prior Office action mailed on July 25, 2003.

Response to Arguments

7. Applicant's arguments filed on October 27, 2003 have been fully considered but they are not persuasive.

Regarding the 102 rejection, applicants argue that the exclusion of the conventional surfactants that is/are used by the reference, Verdol et al., and the special range of the use

of the imidized surfactant, makes the claims novel and non-obvious. Applicants also argue that the limitation on the use of the composition is not taught by the cited reference.

The above arguments are not convincing for the following reasons:

- a) The exclusion of those surfactants, as claimed, constitute new matter:
- b) Even if the accessory surfactants are excluded, the reference, Verdol et al, teaches that use of those surfactants is optional and not required in all instances, see column 7, lines 55-73, specially lines 66-67, which teaches, “[W]hen employed, the accessory emulsifiers. . .” Even though the examples include the use of other(s) surfactants, an invention is not limited by its examples. It has been held that “[A] disclosure in a reference is not limited to its specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested thereby to one of ordinary skill in the art.” *In re Uhlig*, 54 CCPA 1300 376 F2d 320; 153 USPQ 460:
- c) As to the use of the composition it has been held that “It is office position that claims in a patent application cannot be held to involve invention, if the composition defined in such claims is not novel, and of course, patents for old compositions of matter based on a new use of such composition without change therein may not lend patentability to claims. *In re Thuau* 30 C.C.P.A. 979, 135 F.2D 344, 57 USPQ 324. The intended use of a composition in a method of making such composition carries not weight, since it does not add any manipulative steps to the process.

Art Unit: 1731

d) Regarding the addition amounts of the imidized surfactant, Verdol teaches a range between 0.1 to 50%, preferably between 2-20%, based on the monomers, which falls within the claimed, see column 7, lines 49-55.

Regarding rejection under 103(a), applicants argue that one of ordinary skill in the art would not find obvious to use the Verdol et al., invention for sizing paper and that they, Verdol et al., do not teach nor remotely suggest the use of the emulsion as a sizing agent. The examiner respectfully disagrees, Verdol et al., teach that the composition could be used as paper coating or for textile sizing. Sizing is a coating process, either to the formed surface sizing or internally coating the papermaking fibers, internal sizing. One of ordinary skill in the art would find obvious the use of the composition taught by Verdol et al., as a paper sizing agent. Moreover, Verdol et al. teach that the composition can be used for sizing textiles, which fibers are usually Cellulosic or derived from cellulose, e.g. rayon. One of ordinary skill in the art would realize the similarity of the sizing process in both, the papermaking and the textile making operations. Sizing agents used in textiles are usually used also in the papermaking and vice versa.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


Art Unit: 1731

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0662.


José A Fortuna
Primary Examiner
Art Unit 1731

JAF